

REMARKS

The above-referenced patent application has been reviewed in light of the Board of Appeal Decision referenced above. Claims 4-10, 12-16, 18-35, 37, 41-42, 52-59, 61, 63, 72-77, and 79-100 stand rejected under 35 USC § 102(e) as being anticipated by US patent publication no. 2002/0056118 by Hunter, et al. (hereinafter, "Hunter"). Claim 11 stands rejected under 35 USC § 103(a) as being unpatentable over Hunter. Claim 78 stands rejected under 35 USC § 103(a) as being unpatentable over Hunter in view of Dodson et al., U.S. Patent No. 6,184,877 (hereinafter, "Dodson"). Claims 43-48 stand rejected under 35 USC § 103(a) as being unpatentable over Hunter in view of Maruo, U.S. Patent No. 6,757,909 (hereinafter, "Maruo"). Reconsideration of the above-referenced patent application in light of the foregoing amendments and following remarks is respectfully requested.

Claims 4-16, 18-35, 37, 41-48, 52-59, 61, 63, 72-169 are currently pending. Claims 60, 62, 64-68, were previously withdrawn in response to a restriction requirement. Claims 4-16, 18-35, 37, 41-48, 52-59, 61, 63, 72-100 are amended. New claims 101-169 are added. No claims are cancelled.

Claims 4-10, 12-16, 18-35, 37, 41-42, 52-59, 61, 63, 72-77, and 79-100 stand rejected under 35 USC § 102(e) as being anticipated by US patent publication no. 2002/0056118 by Hunter, et al. (hereinafter, "Hunter"). In response, Assignee respectfully traverses this rejection of these claims. It is noted that these claims have been amended. For at least the reasons set forth below, Assignee submits that Claims 4-10, 12-16, 18-35, 37, 41-42, 52-59, 61, 63, 72-77, and 79-100 are not anticipated by Hunter.

The Examiner is reminded that the Manual of Patent Examining Procedure ("MPEP"), in § 2131, states:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Thus, under 35 U.S.C. § 102, a claim is anticipated *only if* each and every element of the claim is found in the cited document. Assignee believes that this standard is not met in this case.

We begin with claim 4, which we noted has been amended. It is respectfully asserted that Hunter does not show or describe each and every element or limitation of claim 4, as amended. It now recites:

A method of wirelessly broadcasting a movie to a set-top box, the method comprising: wirelessly broadcasting packetized movie data to a set-top box so that the packetized movie data broadcast to the set-top box is capable of being stored and incrementally assembled to form at least one full movie and associated metadata, so that the packetized movie data broadcast to the set-top box, after full assembly, is further capable of being analyzed based at least in part on the associated metadata, and so that the at least one full movie is viewed based at least in part on the analysis of the metadata and in response to a user's selection of the at least one full movie.

It is noted that Hunter does not show, describe, or disclose wirelessly broadcasting packetized movie data to a set-top box so that the movie can be incrementally assembled along with associated metadata. To the contrary, Hunter teaches away from the subject matter claimed and, instead, is directed to real-time deliver of movie content or compressed real-time delivery.

Not only is Hunter missing elements of claimed subject matter, such as claim 4, as just explained. Furthermore, Hunter could not be modified to provide claimed subject matter, such

as claim 4, as amended, without the exercise of inventive skill. As explained above, Hunter is directed to real-time delivery or compressed real-time delivery. Therefore, Hunter could not be modified to effectively multiplex content and metadata over the airwaves in packetized form, as a result being delivered based on available bandwidth, so that incremental assembly may take place at non-scheduled times. Mere substitution would not be sufficient here because packetizing the content and metadata means that timing of the delivery of the full content is not specified or specific. Thus, a modification regarding management of the content itself so that it is available for viewing at the appropriate time is a further feature missing from Hunter.

It is noted that the remaining rejected claims, 5-10, 12-16, 18-35, 37, 41-42, 52-59, 61, 63, 72-77, and 79-100, include similar limitations to those discussed above with respect to claim 4. Therefore, the other rejected claims patentably distinguish from Hunter for at least the same or a similar reason.

For at least the reasons above, Assignee respectfully submits that claims 4-10, 12-16, 18-35, 37, 41-42, 52-59, 61, 63, 72-77, and 79-100 all patentably distinguish over Hunter and Assignee respectfully requests that these claims be permitted to proceed to allowance. While additional arguments exist for distinguishing Hunter, the foregoing is believed sufficient.

It is also noted that claim 11 stands rejected under 35 USC § 103(a) as being unpatentable over Hunter. Claim 78 stands rejected under 35 USC § 103(a) as being unpatentable over Hunter in view of Dodson et al., U.S. Patent No. 6,184,877 (hereinafter, "Dodson"). Claims 43-48 stand rejected under 35 USC § 103(a) as being unpatentable over Hunter in view of Maruo, U.S. Patent No. 6,757,909 (hereinafter, "Maruo"). The rejection of

these claims on this basis is respectfully traversed. It is noted that these claims have been amended.

The Examiner is reminded that to successfully make a prima facie rejection under 35 USC § 103, the Examiner must show that Assignee's claimed subject matter would have been obvious to one of ordinary skill in the art pertinent to Assignee's claimed subject matter at the time it was made. See, KSR International, Co. v. Teleflex, Inc., US Supreme Court (decided April 30, 2007). Some of the factors to consider in this analysis include the differences between the applied documents and Assignee's claimed subject matter, along with the level of skill associated with one of ordinary skill in the art pertinent to Assignee's claimed subject matter at the time it was made. One way in which an Examiner may establish a prima facie case of unpatentability under 35 USC § 103 would be to show that three basic criteria have been met. First, the Examiner should show that the applied documents, alone or in combination, disclose or suggest every element of Assignee's claimed subject matter. Second, the Examiner should show that there is a reasonable expectation of success from the proposed combination. Finally, the Examiner should show that there was some suggestion or motivation, either in the applied documents themselves or in the knowledge generally available to one of ordinary skill in the art pertinent to the claimed subject matter at the relevant time, to modify the document(s) or to combine document teachings. The motivation or suggestion to make the proposed combination and the reasonable expectation of success should be found in the prior art, and should not be based on Assignee's disclosure. See, In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); See, MPEP § 2142; 2143 - § 2143.03 (regarding decisions pertinent to each of these criteria). It is respectfully asserted that the Examiner has not met these standards.

Even under the PTO guidelines released after the KSR decision, the Examiner should still demonstrate that each and every element of the rejected claims is shown by the applied documents. However, that is not possible here based on these applied documents with respect to the rejected claims, as amended. The rejected claims, 11, 43-48, and 78, all depend from claims discussed above. None of the applied documents, Dodson and Maruc, whether viewed individually or in combination with Hunter, disclose the features of claimed subject matter discussed above that is missing from Hunter. Furthermore, as indicated above, Hunter, if anything, teaches away from claimed subject matter, as amended. Therefore, it is respectfully requested that the rejection of these claims also be withdrawn and these claims be permitted to proceed to issuance.

For at least the reasons above, Assignee respectfully submits that claims 4-16, 18-35, 37, 41-48, 52-59, 61, 63, and 72-100 all patentably distinguish over the documents applied by the Examiner and respectfully requests that these claims be permitted to proceed to allowance.

In addition, new claims 101-169 have been added. These claims depend from the claims discussed above and therefore patentably distinguish from the applied documents on at least the same or similar bases as previously described as well; however, it is believed that these claims patentably distinguish from the applied documents for additional reasons.

For example, many of these new claims are directed to datacasting and to employing terrestrially broadcast television signals to transmit the packetized content and metadata wirelessly. Furthermore, many of these new claims are directed to integrating transmission of a media asset over a network for viewing with the packetized content data. These are

additional features not disclosed by the applied documents, whether viewed individually or in combination. Furthermore, providing these features involves the application of inventive skill. One of ordinary skill in the art could not employ mere substitution to provide such features in connection with the broadcast of packetized content data and packetized metadata to a set-top box.

Therefore, it is respectfully asserted that these new claims also patentably distinguish from the applied documents. It is therefore respectfully requested that the Examiner permit these claims to proceed to issuance without delay.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the claims pending in this patent application are in condition for allowance. If the Examiner has any questions, he is invited to contact the undersigned at (503) 439-6500. Reconsideration of this patent application and early allowance of all the claims is respectfully requested.

Please charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account number 50-3130.

Respectfully submitted,

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